



DOCKET NO: 249871US2S DIV

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
SHINICHI KIKUCHI, ET AL. : EXAMINER: NGUYEN, H. T.  
SERIAL NO: 10/800,761 :  
FILED: MARCH 16, 2004 : GROUP ART UNIT: 2616  
FOR: DIGITAL VIDEO SYSTEM :

PETITION TO MAKE SPECIAL UNDER MPEP §708.02(VIII)

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

**I. Basis for the Petition**

Pursuant to MPEP §708.02(VIII) (8<sup>th</sup> ed. Rev. 2004), Applicants hereby petition for a special status for this Application.

**II. Requirements for Granting Special Status**

MPEP §708.02(VIII) established five requirements for a grant of special status. The following subsections show that each of these five requirements is satisfied in the above-identified case.

**A. Submit Petition and Fee: §708.01(VIII)(A)**

This petition is accompanied by the fee set forth in 37 C.F.R. §1.17(h).

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**B. Agree to an Election Without Traverse: §708.02(VIII)(B)**

Applicants submit that Claims 17-20 as filed in the Supplemental Preliminary Amendment included herewith are directed to a single, patentable invention. If a restriction requirement is imposed in this Application, Applicants agree to elect without traverse.

**C. State that a Preexamination Search was Made: §708.02(VIII)(C)**

The International Bureau of WIPO conducted a search for International application No. PCT/JP99/03668, to which the present application claims priority. The search conducted for International application No. PCT/JP99/03668 qualifies as a preexamination search because the present application has not been examined on the merits and because we believe the disclosure, including the claims, of the present application is substantially identical to the disclosure of International application No. PCT/JP99/03668, as the present application is a member of the same patent family as International application No. PCT/JP99/03668. For example, both the present application and the parent application recite similar elements, such as audio/video data is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information.

The International Search Report in International application No. PCT/JP99/03668 lists eight "A" references and no "X" or "Y" references. The International Search Report indicates the search included classification system IPC 7, classifications G11B and H04N.

**D. Submit a Copy of the Most Relevant References: §708.02(VIII)(D)**

The references cited in the International Search Report were made of record in the information disclosure statement filed March 16, 2004. All references now of record are discussed below with reference to the claimed subject matter of Claims 17-20.

**E. Submit a Detailed Discussion of the References, Pointing Out How the Claimed Subject Matter is Patentable Over the References: §708.02(VIII)(E)**

Consistent with the International Search Report, Applicants submit that the independent claims of the present invention patentably distinguish over the references cited in the International Search Report. Additionally, Applicants submit that the independent claims of the present invention patentably distinguish over all of the references of record, including those references not cited in the International Search Report. Reasons for the patentability of each of the independent claims are provided below.

Claim 17 recites an information recording medium comprising, *inter alia*:

...  
said movie video object general information includes temporary erase information of a first video object of said video objects,  
a second video object of said video objects is configured to be set at a temporarily erased state, said temporarily erased state indicated by said temporary erase information,  
said second video object corresponding to said temporarily erased state and said first video object result from a division of an original video object including said audio/video data,  
....

U.S. Patent No. 5,751,371 (Shintani) describes a picture receiving apparatus configured to receive digital data, compress the data, and record the data on a minidisk 300B.<sup>1</sup> The data is recorded on minidisk 300B in the format shown in Figure 4 of Shintani.

It is respectfully submitted that Shintani does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object

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<sup>1</sup> Shintani, Abstract.

corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

U.S. Patent No. 5,991,798 (Ozaki et al., hereinafter Ozaki) describes a package medium having a Uniform Resource Locator (URL) stored thereon.<sup>2</sup> The package medium may be used by a terminal,<sup>3</sup> which also stores email. The email may be deleted from the terminal.<sup>4</sup>

It is respectfully submitted that Ozaki does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

U.S. Patent No. 5,999,698 (Nakai et al., hereinafter Nakai) relates to a read only memory device. While Nakai does describe an access restriction flag and an STC discontinuity flag in Figure 42, these flags are not analogous to the temporarily erased state of the present invention. The STC discontinuity flag, as described in column 60 of Nakai, relates to whether or not a current cell has a preceding cell, irrespective of an erasure state of the cell. The access restriction flag of Nakai, described in column 59, for example, relates to whether or not data may be reproduced. When the access limit flag is set to inhibit reproduction, the flag is set to have the same contents for all the cells in one block.

Thus, it is respectfully submitted that Nakai does not disclose or suggest an information recording medium including movie video object general information, wherein

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<sup>2</sup>See Ozaki, Abstract.

<sup>3</sup>See Ozaki, column 9, lines 7-13.

<sup>4</sup>See Ozaki, column 11, lines 33-35 and column 12, lines 10-12.

the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

U.S. Patent No. 6,078,727 (Saeki et al., hereinafter Saeki) describes an optical disc including a data area for storing one or more video objects and a time map area for storing time map information.<sup>5</sup> Saeki describes permanently deleting a portion of a video object stored on the optical disc.<sup>6</sup>

However, it is respectfully submitted that Saeki does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

U.S. Patent No. 6,181,870 (Okada et al., hereinafter Okada) describes an optical disc including a data area for recording a plurality of video segments and an index area for recording original type chain information and user-defined chain information.<sup>7</sup> Okada describes permanently deleting a portion of a video object stored on the optical disc.<sup>8</sup>

However, it is respectfully submitted that Okada does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first

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<sup>5</sup>See Saeki, Abstract.

<sup>6</sup>See Saeki, column 10, lines 48-60 and Figure 13.

<sup>7</sup>See Okada, Abstract.

<sup>8</sup>See Okada, column 32, line 41 to column 33, line 60 and Figures 15 A to 15D.

video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

U.S. Patent No. 6,396,998 (Nozaki et al., hereinafter Nozaki) describes a method for copying information from a copy-protected DVD to preserve the picture quality of video data and copy protection information while copying the information at high speed.<sup>9</sup>

Accordingly, it is respectfully submitted that Nozaki does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

U.S. Patent No. 6,453,119 (Maruyama et al., hereinafter Maruyama) describes an information recording medium including a first area for storing picture data, a second area for storing control data, and a third area in the second area for storing the storage position of representative picture data.<sup>10</sup> Data can be permanently erased by rewriting over the data.<sup>11</sup>

However, it is respectfully submitted that Maruyama does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video

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<sup>9</sup>See Nozaki, column 2, line 30 to column 3, line 62.

<sup>10</sup>See Maruyama, Abstract.

<sup>11</sup>See Maruyama, column 31, lines 45-58 and Figures 24A and 24B

object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

European Patent Application No. 0 406 021 (hereinafter '021') describes a compact disc including an information recording area and a table of contents (TOC) area including information of the portions of the disc having data written thereon, followed by an end mark.<sup>12</sup> When new information is written on the disc, the previous end mark in the TOC is overwritten by the location of the new data, and a new end mark is written after this new location data, rather than rewriting the entire TOC. Thus, the time necessary to record information is reduced.<sup>13</sup>

Accordingly, it is respectfully submitted that '021' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

International Patent Publication No. WO98/22947 (hereinafter '947') describes an optical disc having areas for storage of data and management information.<sup>14</sup> The data is written on the data area contiguously after the management area, and the management information includes status information of an address of the last data written on the disc. This allows new data to be written on the disc in the first available contiguous address.<sup>15</sup>

Thus, it is respectfully submitted that '947' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie

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<sup>12</sup>See '021', page 14, lines 31-38.

<sup>13</sup>See '021', page 14, lines 31-38.

<sup>14</sup>See '947', page 4, lines 7-32.

<sup>15</sup>See '947', page 5, line 15 to page 6, line 23.

video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

European Patent Application No. 0 833 337 (hereinafter '337') describes a recording medium onto which data can be stored.<sup>16</sup> '337' describes a method of permanently erasing data from the medium, if a switch is set to permit erasure.<sup>17</sup>

However, it is respectfully submitted that '337' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

European Patent Application No. 0 680 046 (hereinafter '046') describes a recording medium onto which management information and data can be stored.<sup>18</sup> '046' describes a method of permanently erasing sections of the data between designated start and end points.<sup>19</sup>

However, it is respectfully submitted that '046' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video

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<sup>16</sup>See '337', Abstract.

<sup>17</sup>See '337', column 19, line 25 to column 24, line 40 and Figures 9A, 9B, 9C, 10, and 11.

<sup>18</sup>See '046', Abstract.

<sup>19</sup>See '046', column 7, line 1 to column 8, line 16 and Figure 6.



object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

European Patent Application No. 0 905 699 (hereinafter '699') describes an optical disc including an area for storing audio/video and an area for storing non-audio/video data.<sup>20</sup> '699' describes permanently deleting a portion of either audio/video data or non-audio/video stored on the optical disc.<sup>21</sup>

However, it is respectfully submitted that '699' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

European Patent Application No. 0 903 742 (hereinafter '742') describes an optical disc including an area for recording an audio/video file and an area for recording a management file.<sup>22</sup> '742' describes a method for permanently deleting data on the disc and re-encoding and multiplexing the remaining data to prevent the occurrence of a seam in the remaining data stream.<sup>23</sup>

It is respectfully submitted that '742' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily

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<sup>20</sup>See '699', paragraphs 55 and 56.

<sup>21</sup>See '699', paragraphs 139-145, 196-200, and 204-209 and Figures 20, 27, 28A, 28B, 30, 31A, and 31B.

<sup>22</sup>See '742', paragraph 51.

<sup>23</sup>See e.g. '742', paragraphs 503-506.

erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

Japanese Patent Application No. 10-222964<sup>24</sup> (hereinafter '964') describes that if the remaining capacity of an optical disc is inadequate, the information currently stored on the disc is analyzed to determine when the currently stored information was saved and if it has been reproduced or not. A portion of the currently stored information may then be erased based on this analysis to increase the remaining capacity.<sup>25</sup>

It is respectfully submitted that '964' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

Japanese Patent Application No. 7-64838<sup>26</sup> (hereinafter '838') describes a method for managing a history of changes of information in a RAM. The method includes permanently erasing information from the RAM.<sup>27</sup>

However, it is respectfully submitted that '838' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video

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<sup>24</sup> Statement of Relevancy included with IDS filed March 16, 2004.

<sup>25</sup> See '964', Statement of Relevancy.

<sup>26</sup> English abstract included herewith.

<sup>27</sup> See '838', Abstract.

object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

Japanese Patent Application No. 10-126739<sup>28</sup> (hereinafter '739') describes an optical disc including an area for storing audio/video data. '699' describes permanently deleting a portion of the audio/video data stored on the optical disc.<sup>29</sup>

However, it is respectfully submitted that '739' does not disclose or suggest an information recording medium including movie video object general information, wherein the movie video object general information includes temporary erase information of a first video object, a second video object is configured to be set at a temporarily erased state, the temporarily erased state indicated by the temporary erase information, and the second video object corresponding to the temporarily erased state and the first video object result from a division of an original video object including audio/video data, as recited in Claim 17.

Claim 18 is dependent from Claim 17, and thus is patentable for at least the reasons described above. Claim 19 recites substantially the same limitations as Claim 17, albeit in a format for a method for recording. Claim 20 recites substantially the same limitations as Claim 17, albeit in a format for a method for reproducing. Therefore, Applicants respectfully submit that the limitations defined by pending Claims 17-20 patentably distinguish over the references of record.

### **III. Conclusion**

The petition to make special meets all the requirements of MPEP §708.02(VIII), and therefore, should be granted. Accordingly, Applicants respectfully request that this Application be advanced out of turn for examination, and that the assigned Examiner,

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<sup>28</sup>English abstract included with IDS filed March 16, 2004.

<sup>29</sup>See '739', Abstract.

Application No. 10/800,761  
Petition to Make Special Under MPEP §708.02(VIII)

pursuant to the suggestions of MPEP §708.02(VIII), contact the undersigned to schedule an interview for advancing the prosecution of this case.

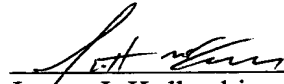
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)



James J. Kulbaski  
Registration No. 34,648  
Attorney of Record  
Scott A. McKeown  
Registration No. 42,866

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